

#17



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

JUN 01 2004

Technology Center 2100

re: Claussen et al.

Serial No.: 09/409,376

Filed: 09/30/1999

For: Method for developing a  
custom tagbean

§ Group Art Unit: 2176

§

§ Examiner: Bieneman, C.

§

§ Atty. Docket #: AT9-99-480

§

Certificate of Mailing  
Under 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is  
being deposited with the United States  
Postal Service as First Class mail in an  
envelope addressed to:  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450  
on May 25, 2004.

By: 

Joseph R. Burwell, Reg. No 44,468

5

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 1.111

The following remarks are offered in response to the final  
Office Action mailed 07/25/2003; a petition for an extension of  
10 time and an RCE are included with this response. Please note  
that although a Notice of Appeal was filed on this patent  
application, a Request for Continued Examination (RCE) is being  
submitted to continue the prosecution of the patent application  
rather than continuing with the appeal process at this time.  
15 No additional fees are believed to be necessary for this  
response; if, however, any fees are necessary, please charge  
Deposit Account No. 50-1888 of Joseph Burwell to cover the cost of  
the fees.

I. General Remarks Concerning This Response

Claims 21-38 are currently pending. In this response, no claims are amended; no claims are added; and no claims are canceled. Reconsideration of the claims is requested.

5

II. Rejections over JavaServer Pages™ Specification Vers. 1.1

The Office action has rejected all of the claims in some manner in view of Pelegri-Llopart et al., *JavaServer Pages™ Specification Vers. 1.1*, Sun Microsystems, Inc., 08/18/1999 (JSP 1.1). The rejections are traversed.

10

Applicant respectfully asserts that Applicant completed and reduced to practice the claimed invention before the publication of JSP 1.1 (August 18, 1999). A declaration, pursuant to 37 C.F.R. § 1.131, has been duly executed by Shane Claussen, an inventor of the present invention; the declaration is included with this response. The inventor declares that Applicant's claimed invention was completed and reduced to practice prior to August 18, 1999. Exhibit "A" to the inventor's declaration is an IBM Invention Disclosure Form that disclosed Applicant's claimed invention. This Disclosure was submitted to the IBM Intellectual Property Law Department in Austin, Texas prior to August 18, 1999. The inventor's declaration under 37 C.F.R. § 1.131, therefore, removes JSP 1.1 from consideration as prior art. Because JSP 1.1 is not prior art with respect to Applicant's claimed invention, the rejection fails to make a *prima facie* case of obviousness in rejecting the pending claims. Applicant respectfully asserts that the claims are allowable.

15

20

25

III. Conclusion

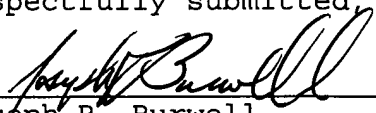
It is respectfully urged that the present application is patentable, and Applicant kindly requests a Notice of Allowance.

30

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

5    DATE:    May 25, 2004

Respectfully submitted,

  
\_\_\_\_\_  
Joseph R. Burwell

Reg. No. 44,468

10

ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell

P.O. Box 28022

Austin, Texas 78755

15

Voice: 866-728-3688 (866-PATENT8)

Fax: 866-728-3680 (866-PATENT0)

Email: joe@burwell.biz